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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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EXAMINER

PIERCE, JEREMY R

ART UNIT	PAPER NUMBER
1771	

DATE MAILED: 03/21/2003

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Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/746,560

Applicant(s)

JOHANSEN, FRIDTJOV

Examiner

Jeremy R. Pierce

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 31 January 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 16-32 is/are pending in the application.
- 4a) Of the above claim(s) 16-24 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 25-32 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 5.

- 4) ☐ Interview Summary (PTO-413) Paper No(s) \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

## **DETAILED ACTION**

### ***Response to Amendment***

1. Amendment B has been filed on January 31, 2003 as Paper No. 10. Claims 1-15 have been cancelled, rendering the rejections set forth in the last Office Action moot. New claims 16-32 have been added.

### ***Election/Restrictions***

2. Newly submitted claims 16-24 directed to an invention that is independent or distinct from the invention originally claimed for reasons set forth in the Restriction requirement in Paper No. 7.

Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claims 16-24 have been withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

### ***Priority***

3. Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.

### ***Specification***

4. The use of the trademark "Station 1" has been noted in this application. It should be capitalized wherever it appears and be accompanied by the generic terminology.

Although the use of trademarks is permissible in patent applications, the proprietary nature of the marks should be respected and every effort made to prevent their use in any manner, which might adversely affect their validity as trademarks.

This matter may be held in abeyance pending allowance. Although Applicant requests that the Examiner make the necessary changes to the specification, the Examiner is not allowed to make such a modification according to MPEP 1302.04.

### ***Claim Rejections - 35 USC § 103***

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 25-28 and 30-32 are rejected under 35 U.S.C. 103(a) as being unpatentable over Doerer et al. (U.S. Patent No. 4,418,031) in view of Barrable (U.S. Patent No. 4,101,335).

Doerer et al. disclose an insulating material comprising base and carrier fibers (column 2, lines 43-67). The carrier fibers are melted through heating to bind the base fibers into a molded form (column 6, lines 22-28). Doerer et al. disclose polyester fibers may be used as the melting carrier fiber (column 4, lines 6-7). Doerer et al. also disclose the addition of shoddy material in order to decrease the cost of insulation

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(column 7, lines 23-26). The base fibers may be any suitable cellulosic material, such as wood, paper, cotton, or jute, or any suitable synthetic material, such as glass, rayon, acetate or mineral wool (column 3, line 66 –column 4, line 3). However, Doerer et al. fail to teach the cellulosic fibers may be flax. Still, flax fibers are recognized in the insulation art as equivalents to the cellulosic fibers disclosed by Doerer et al. Barrable teaches flax to be a useful fibrous cellulosic material in insulation, along with wood, jute, or cotton (column 2, lines 20-26). It would have been obvious to one having ordinary skill in the art to use flax fibers as the base fibers in Doerer et al., since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use. *In re Leshin*, 125 USPQ 416. With regard to claims 26, 31, and 32, although Doerer et al. does not explicitly teach the limitations of melting point and size, it is reasonable to presume that said limitations are inherent to the invention. Support for said presumption is found in the use of similar materials (i.e. polyester fibers) and in the similar production steps (i.e. melting the polyester fibers to bind cellulosic fibers) used to produce the insulation. The burden is upon the Applicant to prove otherwise. *In re Fitzgerald*, 205 USPQ 594. In the alternative, the claimed melting point ranges and fiber sizes would obviously have been provided because both are result effective variables. The melting point of the polyester would be a result effective variable that can be adjusted to optimize the desired processing temperature of the material. It would have been obvious to a person having ordinary skill in the art to use polyester in the claimed melting point ranges, since it has been held that discovering an optimum value of a result effective variable involves only routine skill in

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the art. *In re Boesch*, 617 F.2d 272, 205 USPQ 215 (CCPA 1980). Additionally, using polyester fibers with a smaller dtex would allow the adhesive to be more uniformly spread throughout the fibrous matrix after the fibers were melted. It would have been obvious to one having ordinary skill in the art to use polyester fibers with a dtex of 3 to 5, since it has been held that discovering an optimum value of a result effective variable involves only routine skill in the art. With regard to claims 27, 31, and 32, Doerer et al. disclose the carrier fibers comprise between 2 and 30% by weight of the mat (column 4, lines 55-57). With regard to claims 5 and 15, Doerer et al. disclose the base fibers comprise between 70 and 95% by weight of the mat and fail to disclose the range to be within 5-50% by weight or 20-30% by weight. However, lowering the amount of cellulosic fibers in favor of increasing the amount of shoddy would be an obvious modification to a person having ordinary skill in the art, motivated by a decrease in cost. It would have been obvious to one having ordinary skill in the art to lower the amount of base fibers used by Doerer et al. and increase the amount of shoddy fibers, since it has been held that discovering an optimum value of a result effective variable involves only routine skill in the art. It should also be noted that using shoddy fibers does not necessarily have to change the chemical make-up of the mat, since shoddy is known in the art to mean re-used. The increase in shoddy material does not have to interfere with amount of cellulosic fibers present in Doerer et al., since shoddy material may consist only of cellulosic materials to begin with. With regard to claim 30, it would be obvious to a person having ordinary skill in the art to form the insulation material into the claimed dimensions to create an insulation mat with a desired size for its intended use.

With regard to claim 32, Doerer et al. do not disclose a heat conductivity measurement, however, it is reasonable to presume that said limitations are inherent to the invention. Support for said presumption is found in the use of similar materials (i.e. polyester fibers, shoddy fibers, and cellulosic fibers) and in the similar production steps (i.e. melting the polyester fibers to bind cellulosic fibers) used to produce the insulation. The burden is upon the Applicant to prove otherwise. In the alternative, it would have been obvious to one having ordinary skill in the art to optimize the heat conductivity in order to create a material with better insulation properties.

7. Claim 29 is rejected under 35 U.S.C. 103(a) as being unpatentable over Doerer et al. in view of Barrable as applied to claims 25 and 27 above, and further in view of Vost et al. (U.S. Patent No. 5,047,453).

Doerer et al. and Barrable do not teach implementing recycled cardboard and/or wastepaper into the shoddy. Vost et al. teach that shredded waste paper is used in shoddy in making insulation material (column 2, lines 47-48). It would have been obvious to one having ordinary skill in the art to use wastepaper in the shoddy, since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use.

### ***Response to Arguments***

8. Applicant's arguments filed in Paper No. 10 have been fully considered but they are not persuasive.

9. Applicant argues the Doerer, Barrable, and Vost references are all concerned with making dense shapes, and not insulation for buildings. However, Doerer (column 2, lines 66-67), Barrable (column 2, line 8-9), and Vost (column 2, lines 55-56) all disclose using their invention for insulation in buildings.

10. Applicant argues that the inventive idea of the present invention is to make an insulation product from recycled scrap materials. However, Doerer discloses using materials from reclaimable sources (column 2, lines 9-15).

11. Applicant argues that insulation mat of the present invention is mostly air and has very low density, which distinguishes it from Doerer, Barrable, and Vost. In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., density) are not recited in the rejected claims. Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

12. Applicant argues that three different types of fibers must be present. Doerer discloses three different types of fibers: cellulosic (column 3, line 68), polyester (column 4, line 7), and shoddy (column 7, line 25). Flax is a type of cellulosic fiber that was not specifically recited by Doerer, so the Barrable reference was used to show that flax fibers are equivalent to the types of cellulosic fibers that Doerer did disclose.

13. Applicant argues that the present invention requires certain proportions. The Doerer reference teaches the claimed proportions, except for the lower amount of flax (cellulosic) fibers. As set forth above, it would be obvious to lower this amount and



increase the amount of shoddy, in order to lower costs. This would only be a matter of replacing one cellulosic-based fiber (flax) in Doerer with another (shoddy).

14. Applicant argues that Barrable and Vost teach using binders. However, the binders disclosed by the references were not used in the rejection. Barrable was only used to show the feature of flax fibers a type of cellulosic fiber usable in Doerer. Vost was only used to show the inclusion of shredded waste paper into the shoddy. Doerer, like Applicant, uses polyester fibers to bind the material.

15. Applicant states that the prior art does not teach one of the main features of the present invention, namely the aerated nature of the admixture of fibrous materials. In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., aerated nature of the fibers) are not recited in the rejected claims. Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

16. Applicant's arguments with respect to the Borger reference are moot in view of the current grounds of rejection.

### **Conclusion**

17. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

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A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jeremy R. Pierce whose telephone number is (703) 605-4243. The examiner can normally be reached on Monday-Thursday 7-4:30 and alternate Fridays 7-4.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Terrel Morris can be reached on (703) 308-2414. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9310 for regular communications and (703) 872-9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0661.



Jeremy R. Pierce  
Examiner  
Art Unit 1771  
March 19, 2003



ELIZABETH M. COLE  
PRIMARY EXAMINER